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NOV 1 2005

In re Application of:

SUZUKI *et al.*

Serial No.: 10/692,750

Filed: October 27, 2003

U.S. Patent No. 6,821,131

Issued: November 23, 2004

Attorney Docket No. 4208.0192

DECISION RETURNING
PRIOR ART CITED UNDER
35 U.S.C. § 301

The prior art citation under 35 U.S.C. § 301 and 37 C.F.R. § 1.501, filed by the patent owner on July 29, 2005, is before the Group Director of Examining Group 2800 for consideration.

STATUTES, REGULATIONS AND PRACTICE

35 U.S.C. § 301 reads as follows:

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential. (Emphasis added.)

37 C.F.R. § 1.501 reads, in pertinent part:

(a) At any time during the period of enforceability of a patent, any person may cite to the Patent and Trademark Office in writing prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of a

Decision Returning Citation of Prior Art by Patent Owner

particular patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. (Emphasis added.)

Section 2205 of the Manual for Patent Examining Procedure (M.P.E.P.) reads, in pertinent part:

The prior art which may be submitted under 35 U.S.C. 301 is limited to "written prior art consisting of patents or printed publications."

An explanation is required of how the person submitting the prior art considers it to be pertinent and applicable to the patent, as well as an explanation of why it is believed that the prior art has a bearing on the patentability of any claim of the patent. Citations of prior art by patent owners may also include an explanation of how the claims of the patent differ from the prior art cited. . . .

A prior art citation is limited to the citation of patents and printed publications and an explanation of the pertinency and applicability of the patents and printed publications. This may include an explanation by the patent owner as to how the claims differ from the prior art. (Emphasis added.)


Section 2206, II, B of the M.P.E.P. reads in pertinent part:

If an improper prior art citation under 37 C.F.R. 1.501 is filed by the patent owner prior to an order for reexamination, it should not be entered in the file. The patent owner should be notified of the nonentry, and the citation papers should be returned to the patent owner along with the notification.

DECISION

The citation of prior art lacks an explanation of the pertinency and the manner of applying the cited prior art to at least one claim of the patent. Accordingly, the citation of prior art filed July 29, 2005 does not meet the requirements for entry into the patent file. The citation is being returned to the patent owner pursuant to M.P.E.P. § 2206, II, B.

This decision is made of record in the patent file.



Richard K. Seidel, TC Director
Technology Center 2800
Semiconductors, Electrical and Optical
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Enclosure: Citation of prior art filed July 29, 2005